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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/582,289

02/20/2007

Doris Reich

3465

2835

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7590

04/02/2008

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EXAMINER

ROSE, ROBERT A

ART UNIT

PAPER NUMBER

3723

MAIL DATE

DELIVERY MODE

04/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/582,289	Applicant(s) REICH ET AL.	
	Examiner Robert Rose	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/12/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of Applicant's Prior Art Statement, filed June 12, 2006.
2. Receipt is acknowledged of Applicant's Foreign Priority papers, filed June 12, 2006.
3. Receipt is acknowledged of Applicant's Preliminary Amendment, filed June 12, 2006.
4. Claims 1-17 are presented for examination.
5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3-7, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 3, lines 3-4 the phrase "the smaller cross-sections" is deemed ambiguous, in that it is unclear to what structure this comparison is in reference. Similarly, in claim 4, lines 3-4 "the larger cross-sections" is deemed ambiguous. Again, in claim 7, line 6 "the smaller cross-section" is ambiguous, in that it is unclear what comparison is being made. In claim 4, line 3 "the longitudinal sides" is without proper antecedent basis. In claim 6, line 4 it is unclear what is "a lateral longitudinal edge". In claim 11, line 5 "the wall" lacks antecedent support. In addition, claim 11 recites the broad recitation "wall", and the claim also recites "cylindrical wall" which is the narrower statement of the range/limitation. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not

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clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-7, 9-10, 12-14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reich et al(US 6514131) in view of Stirm. Reich et al discloses an electric hand-held power tool with a machine housing having a dust-ejection opening, and a dust-collection container with a box and cover, connected thereto. While the dust-collection box is constructed to be removable from the machine housing for emptying, it would have been obvious in view of Stirm, to have constructed the dust-collection box as an integral portion of the machine housing, and formed the cover and filter section as a removable element for alternately emptying the dust from the unit, for

convenience and to avoid misplacing the dust-collection box. With regard to claim 2, the specific shape of the dust-collection box is regarded as being one of obvious design choice to those of ordinary skill in the art in the absence of a clear showing of criticality with respect to the particular shape recited. With regard to claim 17, the dust collection box in Reich et al is considered to form a portion of the handle, as it attaches to a lower section of the handle opening.

9. Claims 8, 11, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reich et al('131) in view of Valentini. Valentini discloses a power tool with a dust-collection box in the form of a cylinder with a pleated filter element. With regard to claim 8, to make the dust-collection box in the form of a cylinder, as taught by Valentini, to maximize the capacity of the filter element, would have been obvious to those of ordinary skill in the art. With regard to claim 15, to embody the filter element in Reich et al as a conventional pleated filter to maximize the area available for filtering, would have been obvious in view of Valentini.

10. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Reich et al('690), Hoshino et al, and Cooper et al are cited of interest to show other power tools with dust-collection boxes. Park is cited to show a power tool having a dust-collection box, with cylindrical shape and having corresponding shaped filter element.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Rose whose telephone number is (571) 272-4494. The examiner can normally be reached on Monday through Thursday, and on alternate Fridays, from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail, can be reached at (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Robert Rose/
Primary Examiner
Art Unit 3723

Rr

March 30, 2008.